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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/719,559	11/21/2003	John A. Underwood	200300317-2	3548

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EXAMINER

CHAU, MINH H

ART UNIT	PAPER NUMBER
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2854

DATE MAILED: 05/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No. 10/719,559	Applicant(s) UNDERWOOD ET AL.	
	Examiner Minh H. Chau	Art Unit 2854	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 February 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-44 is/are pending in the application.
- 4a) Of the above claim(s) 15-23 and 26-44 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 7, 8, 10, 13, 14, 24 and 25 is/are rejected.
- 7) ☒ Claim(s) 6, 9, 11 and 12 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 11/21/2003.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of the invention of **Species (A)** (claims 1-14, 24 and 25) in the reply filed on 02/13/2006 is acknowledged. The traversal is on the ground(s) that *"in searching for references regarding each of the claims in Species A, B, C, or D, the Examiner will likely be identifying references applicable to each of the independent claims in the other species. Therefore, a search for references to allow examination on the merits of all independent claims in the present application will not create a serious burden on the Examiner"*. This is not found persuasive because first, the subject matter of **Species (B)**, claims 15-23, 26-28 and 37-44 is directly of a method for processing print material including the steps of operating on the sheet of material according to the one or more instructions provided by the identified eye mark; **Species (C)**, claims 29-33 is directly to a print medium having processing instructions comprising a number of color eye marks, wherein the number of color eye marks provide a first process instruction and a second process instruction and **Species (D)**, claims 34-36 is directly a device for encoding information onto a material, while **Species (A)**, claims 1-14, 24 and 25 is directly to a method for using eye marks including the step of encoding instructions in the eye mark based upon the combination of the at least two sections; which do not required the specific features or method steps of **Species (B)-(D)**, in order to operate; and second in search for the subject matter or references of **Species (A)** do not necessarily to include all the search area or references that applicable to each of the independent claims in the other species. Therefore, the search and examination of the

entire application is a serious burden upon the Examiner. The requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. **Claims 1-4, 7, 8, 10, 24 and 25** are rejected under 35 U.S.C. 102(b) as being anticipated by *Inoue et al.* (US # 3,835,297).

With respect to **independent claims 1 and 24**, *Inoue et al.* teach a method and a computer readable medium having a set of computer executable instructions to cause a device to perform for using color index code marks or eye marks (6), comprising providing an eye mark (Figs. 3 & 4) having at least two sections arranged along a longitudinal axis (Fig. 4), wherein each section includes a border common to both sections (Fig. 4) and a unique characteristic relative to other sections (col. 3, lines 54-63) and encoding instructions in the eye mark based upon the combination of the at least two sections (col. 4, lines 1-8 and cols. 7-9), the types of information (instructions) of microfilm is being determining or encoding based on the number or the combination of code marks in the color index code.

With respect to **claim 2**, see Fig. 4 and col. 3, lines 54-63 of *Inoue et al.* that teach a method of providing color index code marks or an eye mark (6) having at least

two sections further includes providing the unique characteristic of each section of the eye mark as a first and a second color characteristic.

With respect to **claim 3**, see Fig. 4 and col. 3, lines 54-63 of *Inoue et al.* that teach a method of providing the unique characteristic of each section of the eye mark as the first and the second color characteristic includes an eye mark having the first and the second color characteristic selected from the colors cyan, magenta, yellow, black, light cyan, light magenta, red, green, and blue.

With respect to **claim 4**, see Fig. 4 and col. 3, lines 54-63 of *Inoue et al.* that teach a method of providing an eye mark having at least two sections includes providing an eye mark having more than two unique color characteristics.

With respect to **claim 7**, see Figs. 3 and 4 of *Inoue et al.* that show an eye mark (6) having at least two sections includes providing an eye mark having a first and a second shape characteristic for the at least two sections.

With respect to **claim 8**, wherein providing an eye mark (6) having a first and a second shape characteristic includes providing a first and a second shape characteristic which are different from one another.

With respect to **independent claims 10 and 25**, *Inoue et al.* teach a method and a computer readable medium having a set of computer executable instructions to cause a device to perform for using color index code marks or eye marks (Figs. 3 & 4), comprising providing an eye mark on microfilm or a print media (Fig. 4 and col. 3), having at least two color sections positioned along a longitudinal axis for parallel sensing (Fig. 4), wherein each color section includes a border common to both sections

and includes a different color characteristic relative other color sections (Fig. 4 and col. 3, lines 54-63), and encoding instructions in the eye mark based on the different color characteristics (col. 4, lines 1-8 and cols. 7-9), the types of information (instructions) of microfilm is being determining or encoding based on the number color code marks in the color index code.

With respect to **claim 13**, see Fig. 4 and col. 3, lines 54-63 of *Inoue et al.* that teach a method of providing an eye mark includes providing an eye mark having at least three color sections positioned for parallel sensing, wherein each color section includes a different color characteristic.

With respect to **claim 14**, see Fig. 4 and col. 3, lines 54-63 of *Inoue et al.* that teach a method of providing an eye mark having at least three color sections includes providing each section with a different color selected from the group of cyan, magenta, yellow, light magenta, light cyan, red, green, and blue.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. **Claim 5** is rejected under 35 U.S.C. 103(a) as being unpatentable over *Inoue et al.* as applied to claims 1-4, 7, 8, 10, 24 and 25.

With respect to **claim 5**, *Inoue et al.* teach the limitation as explained in the rejection above, except for an eye mark having a white characteristic section.

Inoue et al. teach an eye mark having at least two sections including an eye mark having a black characteristic and a color characteristic for the at least two sections (Fig. 4 and col. 9, lines 2-10); *Inoue et al.* also discuss the use of an eye mark having a white characteristic section by the prior art (col. 9, lines 6-10).

In view of this teaching, it would have been obvious to one of skill in the art to modify the method for using eye mark of *Inoue et al.* to including an eye mark having a white color characteristic section as taught by the prior art as mentioned in the *Inoue's* reference so that a variety difference colors can be use in eye mark thus provides information encode in eye mark can be increased.

Allowable Subject Matter

6. **Claims 6, 9, 11-12** are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

7. The following is a statement of reasons for the indication of allowable subject matter:

Claim 6 has been indicated for containing allowable subject matter because the combination of a method for using eye mark including the step of providing an eye mark having at least two sections includes providing an eye mark having a color characteristic and a location characteristic for the at least two sections could not be found in the prior art of record.

Claim 9 has been indicated for containing allowable subject matter because the combination of a method for using eye mark including the step of providing an eye mark having at least two sections includes providing a first and a second characteristic for the at least two sections that have at least a three bit binary structure could not be found in the prior art of record.

Claims 11 and 12 have been indicated for containing allowable subject matter because the combination of a method for using eye mark including the step of encoding instructions in the eye mark based on the different color characteristics further includes encoding a processing instruction using one or more different color characteristics.

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The Applicant's attention is invited to the patents to Papritz et al. (US # 6,109,183), Geissler et al. (US # 5,696,890), Fujimoto et al. (US # 5,355,001) Brunner (US # 4,852,485) and Jeschke et al. (US # 4,606,633).

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Minh H. Chau whose telephone number is (571) 272-2156. The examiner can normally be reached on M - TH 9:30AM - 8:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew H. Hirshfeld can be reached on (571) 272-2168. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2854

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MHC
May 10, 2006


MINH CHAU
PRIMARY EXAMINER